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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

In the Matter of the

APPLICATION OF FREDERICK C. FOSTER, *Petitioner*

PETITION FOR REHEARING

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PETITION FOR REHEARING

Petitioner prays that this Court grant rehearing of its order of April 4, 1966 denying the petition for writ of certiorari, — U.S. —, 16 L. Ed. 2d —, and that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals in the above-entitled case as prayed for in the petition filed July 14, 1965 herein.

The Intervening Circumstances

The "intervening circumstances of substantial and controlling effect" (Rule 58) on which this petition for rehearing is predicated are:

(a) the February 21, 1966 decisions of this Court in *Graham* v. *John Deere Co.*, — U.S. —, 15

L. Ed. 2d 545, and *United States* v. *Adams,* — U.S. —, 15 L. Ed. 2d 572, with which the decision below is in conflict; and

(b) the August 31, 1965 decision of the Court of Appeals of the Sixth Circuit in *Felburn* v. *The New York Central Railroad Company,* 350 F. 2d 416, *cert. den.,* — U.S. —, 15 L. Ed. 2d 852 (1966), and the September 14, 1965 decision of the Court of Appeals of the Fifth Circuit in *Bros Incorporated* v. *W. E. Grace Manufacturing Company,* 351 F. 2d 208, *cert. den.,* — U.S. —, 15 L.Ed. 2d 852 (1966), with which the decision is also in conflict.

The Conflict With Graham and Adams

(1) *Graham* and *Adams* hold that novelty (35 U.S.C. 102(a) and (b)) and "nonobviousness" (35 U.S.C. 103) are "separate tests of patentability" (*United States* v. *Adams,* — U.S. —, 15 L. Ed. 2d 572, citing *Graham*). "Nonobviousness" under section 103 is to be determined "at the time the invention was made" as that statute in terms requires.

Speaking with respect to the separate nonobviousness test of section 103, *Graham* recognizes that:

> "The first sentence of this section is strongly reminiscent of the language in *Hotchkiss.* Both formulations place emphasis on the pertinent art existing *at the time the invention was made* . . ." 15 L. Ed. 2d 545, 554.*

In invalidating the Scoggin patent for failure to meet the "nonobviousness" test of section 103, the Court said:

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* Unless otherwise indicated, emphasis has been supplied.

> "... To us, the limited claims of the Scoggin patent are clearly evident from the prior art as it stood *at the time of invention.*" 15 L. Ed. 2d 545, 567.

In *Adams,* the Court, in sustaining the patent in suit, observed:

> "... We have seen that *at the time Adams perfected his invention* noted experts expressed disbelief in it...." 15 L. Ed. 2d 572, 580.

(2) In direct conflict with *Graham* and *Adams,* the decision below confuses the separate statutory tests of patentability to hold that "nonobviousness" under section 103 is to be determined *not* "at the time the invention was made" as that statute provides but, instead, as of "one year prior to the application for patent", the time limitation specified in the separate novelty statute, 35 U.S.C. 102(b).

This anomalous result was reached below by interpretation of the word "described" in section 102(b) to include printed publications in which "the invention is not ... described as set forth in section 102 ..." and with which section 103 exclusively is concerned.[1]

In short, as the dissenting judge below aptly observed, and as respondent concedes,[2] the decision below

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[1] The first sentence of section 103 states in pertinent part:

> "A patent may not be obtained though the invention is not ... described as set forth in section 102 of this title, if the differences ... would have been obvious at the time the invention was made ..."

[2] R. Br., p. 8, footnote 6.

"... destroys any meaningful differences that may have existed in the past between sections 102(a) and (b) and section 103 ...." (Pet. App. 38a)[3]

(3) The emasculation of section 103 is a subject of widespread concern to legal scholars whose writings emphasize the importance and legally untenable consequences of the decision below.

Typical statements include the following:

"*Foster* . . . has rendered section 103 a mere redundancy." "Section 103 Obviousness as a Time-bar Under Section 102 (b)", 44 N. Car. L. Rev. 208, 224 (1965).

"... section 103 ... becomes redundant ..." Note, 11 Vill. L. Rev. 184, 188 (1965).

". . . by adopting the construction that section 102(b) *includes* obviousness within the word 'describes,' (sic) resort to section 103 is unnecessary." Note, 34 Geo. Wash. L. Rev. 376, 380 (1965).

". . . Since it appears that there is no difference between the two tests [under 102(b) and 103], the need for resorting to section 103 . . . should be relatively rare. . . .

"Moreover, the expansion by the *Foster* court of the word 'describe' in section 102(b) to encom-

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[3] This conclusion is compelled even by a casual examination of the statute.

The word "described" must have the same meaning in both sections 102(a) and (b) since both sections spring from and recodify the *single* occurrence of that word in R. S. 4886.

Adopting the lower court construction of the word "described", section 102(a), *like section 103,* would provide that a patent shall not be granted if

"the invention was . . . described in a printed publication . . . *or became obvious* . . . before the invention thereof by the applicant. . . ."

> pass 'describe or make obvious', might suggest a similar expansion in section 102(a) . . . . and section 103 would be largely redundant. . . ." Note, 54 Georgetown Law Journal 720, 724. (1966)

See, generally, "Obviousness under Section 103", XLVII JPOS, No. 10, 811, 830 (1965); "Prior Art and Obviousness", XLVII JPOS, No. 2, 79 (1965).

The Conflict With Felburn and Bros

(1) The crux of the conflict between the decision below and the rulings of this Court in *Graham* and *Adams* lies in the unjustifiably broad interpretation by the Court of Customs and Patent Appeals of the word "described" in section 102(b).

This specific conflict unfortunately is only one aspect of the massive confusion in the lower courts with respect to the proper interpretation of the word "described" in the novelty statutes. This fundamental conflict is significantly evidenced by the contrary lines of authority which have developed since this petition was filed on the issue of whether the word "described" in section 102(b) is satisfied *only* by an identical disclosure in a single printed publication of the very invention claimed.

The decision below rejected such a construction of the word "described", stating:

> ". . . the *contention seems to be that 102(b) has no applicability where the invention is not completely disclosed in a single patent or publication* . . . we think this contention is unsound . . . " (Emphasis in original) (Pet. App. 18a).

To the same effect on this point is the prior decision in *Bros Incorporated* v. *Browning Manufacturing Co.*,

317 F. 2d 413 (8 Cir. 1963), *cert. den.* 375 U.S. 825, 11 L. Ed. 2d 58, 84 S. Ct. 67, *rehearing den.*, — U.S. —, 15 L. Ed. 2d 857 (1966). *Bros Inc.* was followed on the same point in *Dix-Seal Corporation* v. *New Haven Trap Rock Company,* 236 F. Supp. 914, 918 (D. Conn. 1964).

(2) The *conflicting* line of authority fundamentally rests upon two appellate decisions intervening between the filing and denial of the petition in this case.

In *Felburn* v. *The New York Central Railroad Company,* 350 F. 2d 416, 420-421,[4] decided August 31, 1965, the Sixth Circuit Court of Appeals held:

> "... there appears to be novelty in the ... assembly defined in claim ... when tested according to the provisions of section 102. That is to say, the inventions claimed in these claims are not 'identically disclosed' in the prior art of record. ..."

In *Bros Incorporated* v. *W. E. Grace Manufacturing Company,* 351 F. 2d 208,[5] decided September 14, 1965, the Court of Appeals for the Fifth Circuit effectively adopted the "identity" construction of the word "described" rejected by the Eighth Circuit in *Bros* v. *Browning, supra,* to sustain under section 102(b) the very patent which the Eighth Circuit invalidated under the same statute in view of the same printed publication reference.

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[4] *Cert. den.*, —— U.S. ——, 15 L.Ed.2d 852 (1966).

[5] *Cert. den.*, —— U.S. ——, 15 L.Ed.2d 852 (1966). On the same day leave to file a petition for rehearing from the denial of the petition for certiorari in the Eighth Circuit case, *Bros* v. *Browning, supra,* was also denied, —— U.S. ——, 15 L.Ed. 2d 857 (1966).

Prompt Resolution of the Conflicting Decisions Is Essential

The denial of the certiorari petition in this case will necessarily aggravate the confusion in the lower courts with respect to the interpretation of the word "described" in the novelty statute, section 102.

The Patent Office unquestionably will follow the decision below and continue to determine the question of obviousness under section 103 by reference to the time-bar provisions of the separate novelty statute, section 102, all in direct contradiction to the rulings of this Court in *Graham* and *Adams*.

The important questions of interpretation of the patent statutes raised by this petition eventually must be resolved by this Court. If the decisions in *Graham* and *Adams* are not to be enervated by the conflicting decision below, immediate review and clarification of the law is essential.

CONCLUSION

For the reasons stated, the April 4, 1966 order denying the petition for writ of certiorari should be vacated and the petition for writ of certiorari should be granted.

Respectfully submitted,

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CERTIFICATE OF COUNSEL

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58 of the rules of this Court.

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